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U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143  
Response to January 27, 2005 Office Action

### **REMARKS**

In response to the Office Action dated January 27, 2005, Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the pending claims distinguish over the cited art of record.

The United States Patent and Trademark Office (the "Office") rejected claims 1-36 under 35 U.S.C. § 102 (e) as being anticipated by U. S. Patent 6,564,261 to Gudjonsson *et al.* The Office also rejected claims 21, 35, and 36 under 35 U.S.C. § 103 (a) as being unpatentable over *Gudjonsson*. The Assignee shows, however, that the amended claims are patentably distinguishable over *Gudjonsson*, and the Assignee thus respectively submits that the pending claims are ready for allowance.

#### **Rejection of Claims 1-36 under 35 U.S.C. § 102 (e)**

The Office rejected claims 1-36 under 35 U.S.C. § 102 (e) as being anticipated by U. S. Patent 6,564,261 to Gudjonsson *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, amended, independent claims 1, 12, and 24, and thus the dependent claims thereunder, are patentably distinguishable over *Gudjonsson*. The reference to *Gudjonsson* does not anticipate this invention, so the Assignee respectfully requests that Examiner Lezak remove the 35 U.S.C. § 102 (e) rejection of claims 1-36.

Independent claims 1, 12, and 24 have been amended. These independent claims recite features for exchanging profile information amongst members. A sender of a communication may make a first request to verify a chosen member's communications presence information. Because code numbers and passwords are exchanged between all the members, the chosen

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member's code number is used to determine which of the chosen member's contact devices are available to receive the communication. That presence information is provided to the sender, and the sender may then make a second selection to initiate the communication with one of the chosen member's available contact devices. A "clean" version of amended claim 1 is reproduced below:

1. A method for identifying to a sender of a communication an availability of members through their contact devices, comprising:

storing a profile on each member, the profile identifying at least one contact device for each member, with each member's profile assigned a random and unique code number, and each member's profile requiring a password to access the profile;

exchanging each member's code number and password amongst the other members to allow each member to access every other member's profile;

receiving a first selection from the sender to verify a chosen member's communications presence information;

using the chosen member's code number to determine which of the chosen member's contact devices are available to receive the communication;

providing the communications presence information to the sender; and

receiving a second selection from the sender to initiate the communication with one of the chosen member's available contact devices.

Independent claims 12 and 24 include similar features. Support for these features may be found at least at page 3, lines 5-7; page 9, lines 3-4; page 12, lines 5-7 and lines 16-18; and page 13, lines 1-14.

*Gudjonsson* does not anticipate independent claims 1, 12, and 24. *Gudjonsson* is silent to "exchanging each member's code number and password amongst the other members to allow each member to access every other member's profile." *Gudjonsson* does teach that each user is given a unique user ID. See, e.g., U. S. Patent 6,564,261 to *Gudjonsson et al.* (May 13, 2003) at

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column 2, lines 55-60. No where, however, does *Gudjonsson* exchange code numbers and passwords amongst the other members. As the independent claims explain, these code numbers and passwords are exchanged "to allow each member to access every other member's profile."

Moreover, *Gudjonsson* fails to teach or suggest other features. The independent claims, for example, recite first and second selections by the sender of the communication. As the claims recite, "receiving a first selection from the sender to verify a chosen member's communications presence information." The claims also recite "receiving a second selection from the sender to initiate the communication with one of the chosen member's available contact devices." No where does *Gudjonsson* permit a sender to first "verify a chosen member's communications presence information." Once the chosen member's presence information is verified, the sender then chooses one of the chosen member's available contact devices. As Examiner Lezak is aware, *Gudjonsson* utilizes a "routing service." The "routing service for the receiving user determines, according to a logic specified by the same receiving user, how the request is handled and what services are available to handle the request." See U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 3, lines 19-22. No where does *Gudjonsson* permit the sender to first "verify a chosen member's communications presence information" before sending the communication. Because *Gudjonsson* fails to teach at least these features, *Gudjonsson* cannot anticipate independent claims 1, 12, and 24. The Assignee, then, respectfully asks the Office to remove the § 102 rejection.

**Rejection of Claims 21, 35, and 36 under 35 U.S.C. § 103 (a)**

The Office also rejected claims 21, 35, and 36 under 35 U.S.C. § 103 (a) as being obvious over *Gudjonsson*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As this

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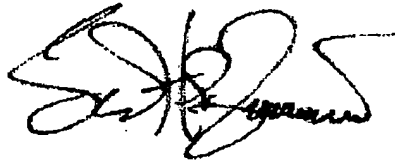
response explains above, *Gudjonsson* does not teach or suggest all the limitations of claims 21, 35, and 36.

Claims 21, 35, and 36 are not obvious in view of *Gudjonsson*. Claims 21, 35, and 36 are dependent claims and, thus, incorporate all the limitations of the respective independent claim. Independent claims 1, 12, and 24, as explained above, have been amended to recite features not taught by *Gudjonsson*. One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Gudjonsson* to obviate claims 1-36. Because *Gudjonsson* does not teach or suggest all the claimed features, the Assignee respectfully requests removal of the § 103 (a) rejection.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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Reg. No. 41,390